

REMARKS

In response to the Office Action dated June 14, 2005, Applicants respectfully request reconsideration based on the following remarks. Applicants respectfully submit that the claims as presented are in condition for allowance.

The drawings were objected to. Replacement drawings were submitted with Applicants' response filed March 9, 2005. Submitted herewith is a duplicate of the replacement sheets of drawings including revisions to overcome the objections.

Claims 1-5, 7-8, 17-25, and 27-38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application 2002/0063656 to Gutowski (hereinafter referred to as "Gutowski") in view of U.S. Patent 5,481,588 to Rickli et al. (hereinafter referred to as "Rickli"). This rejection is respectfully traversed for the following reasons.

The cited documents do not teach or suggest all of the claim elements. Specifically, neither Gutowski or Rickli teach or a system for determining mobile communications system carrier propagation characteristics, wherein the mobile communications system does not decrease system capacity during the operation of said system for determining mobile communications system carrier propagation characteristics.

Gutowski discloses a measuring system that includes a scanning receiver, a GPA and a laptop. Gutowski teaches a system for determining mobile communications system carrier propagation characteristics that requires individual antennas on each sector to be keyed-up and constantly transmit on a particular frequency referred to as the keyed-up signal. The requirement that the antennas constantly transmit on a particular frequency reduces the number of available frequencies for subscriber communications and thereby reduces the capacity of the mobile communications system. Therefore, Gutowski does not teach or disclose all of the elements of independent claims 1, 17, 29, 33, or 36.

Furthermore, Rickli does not cure the deficiencies of Gutowski. Rickli discloses a test arrangement for radio telephone systems that includes using mobile test units to place calls using the mobile communications system and record data about the call. The system disclosed in Rickli reduces the available capacity of the mobile communications system.

The Examiner states that the combination of Gutowski and Rickli inherently teaches that the mobile communications system does not decrease system capacity during the operation of said system for determining mobile communications system carrier propagation characteristics. Applicants submit that reliance on inherency is not appropriate in this application.

With respect to inherency, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. See MPRP § 2112. In the present case, the Examiner has not provided any evidence to indicate that the missing feature is necessarily present in the Gutowski or Rickli. Gutowski actually teaches against the missing feature by requiring individual antennas on each sector to be keyed-up and constantly transmit on a particular frequency referred to as the keyed-up signal, thereby eliminating one frequency that could be used for system capacity. There is no evidence establishing that this feature is inherent in either Gutowski or Rickli.

The Examiner also asserts that the claimed feature of not decreasing system capacity is just a functional limitation and does not distinguish the claimed apparatus from the prior art. First, assuming the Examiner's position correct, this doctrine is only applicable to the system claims. In method claims 17-32, clearly functional elements must be considered. Furthermore, with respect to the system claims, the wherein element describes how the system operates and does distinguish the system from prior art systems. The doctrine cited by the Examiner applies to physical, structural items, not systems such as the claimed telecommunications system. Using the Examiner's approach, no computer implemented systems could be patented as a general purpose

computer system is only distinguishable from the prior art based on what it does, not its structure. Clearly, this is not the appropriate standard under patent law. In fact, MPEP § 2173.05(g) states that a functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used.

The Examiner also states that the system of Gutowski and Rickli is capable of performing such function. This position, however, is analogous to the "obvious to try" rationale that has been criticized by the courts and the MPEP. As noted in MPEP § 2143.01, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

Claims 1, 17, 29, 33, or 36 are believed to be allowable since Gutowski and Rickli combined do not teach or disclose all of the elements the claims; additionally dependant claims 2-4, 7-8, 17-25, and 27-38 are believed to be allowable, at least due to their dependency on claims 1, 17, 29, 33, or 36.

Claim 26 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Gutowski in view of Rickli and further in view of U.S. Patent No. 6,201,803 to Munday et. Al (hereinafter referred to as "Munday"). Munday, however, does not cure the deficiencies of Gutowski and Rickli discussed above. Claim 26 includes features similar to those discussed above with reference to claim 17 and is patentable over Gutowski in view of Arpee and further in view of Munday for at least the reasons advanced with respect to claim 17.

In view of the foregoing remarks, Applicants submit that the above-identified application is now in condition for allowance. Early notification to this effect is respectfully requested.

If there are any charges with respect to this response or otherwise, please charge them to Deposit Account 06-1130 maintained by Applicants' attorneys.

Respectfully submitted,

By: 

David A. Fox
Registration No. 38,807
CANTOR COLBURN LLP
55 Griffin Road South
Bloomfield, CT 06002
Telephone (860) 286-2929
Facsimile (860) 286-0115
Customer No. 36192

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